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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,898	11/28/2000	Leroy Hood	066661-0021	7808
41552	7590	09/25/2008		
MCDERMOTT, WILL & EMERY 4370 LA JOLLA VILLAGE DRIVE, SUITE 700 SAN DIEGO, CA 92122			EXAMINER ZEMAN, MARY K	
			ART UNIT 1631	PAPER NUMBER
			MAIL DATE 09/25/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/724,898

Applicant(s)

HOOD ET AL.

Examiner

Mary K. Zeman

Art Unit

1631

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 6-9, 11, 13, 15, 16, 65, 70-80, 90, 95-104, 138, 139, 141 and 144-189 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6, 9, 11, 13, 15, 16, 65, 70, 73, 75, 77, 79, 90, 97, 99, 101, 103, 138, 139, 141, 144 and 147-189 is/are rejected.
- 7) ☒ Claim(s) 7, 8, 11, 72, 74, 76, 78, 80, 95, 96, 98, 100, 102, 104, 145 and 146 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6/10/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1, 6-9, 11, 13, 15, 16, 65, 70-80, 90, 95-104, 138, 139, 141 and 144-189 are pending.

The IDS statement filed 6/10/08 has been entered and considered.

The amendments and arguments filed 6/10/08 have been entered and carefully considered. Rejections of record not re-iterated below have been withdrawn.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1,6 , 9 11, 13, 15-16, 65, 70, 73, 75, 77, 79 ,90,97, 99, 101, 103, 138-139, 141, and 144, 147-189 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. This rejection is maintained.

This statement of rejection has been modified to fully comply with current MPEP and policy directions. The changes to this rejection result in this action being held as non-final.

The rejected method and system claims are non statutory. The recent amendments will be addressed below.

The method of the independent claims does not provide a transformation of matter. The step of contacting a specimen with a target does not clearly transform one state of matter to another. The method is not clearly tied to another class of invention, such as an array, or specifically programmed computer. The above rejected claims do not recite a specific practical

application, nor do they clearly provide a concrete, tangible and useful result. The end of the method now recites an output step, but the nature of the output is a “health state” which does not have a clear immediate use, or application.

The examiner has closely considered the amendments and dependent claims. For example, the inclusion of the “disease state”, “course of disease” would appear to render the result concrete, tangible and useful. Similarly, reporting a result which lies within two categories (reference or perturbed) would provide a concrete, tangible and useful result. The limitation of clearly measuring the expression molecules through contact with an array would appear to tie the method to another class of invention, and provide a transformation of matter.

Applicant is directed to MPEP 2106.IV.C.2, and recent court decisions such as *ex parte Bilski*, *In re Benson*, *In re Comiskey*, etc.

Claims 1,6 , 9 11, 13, 15-16, 65, 70, 73, 75, 77, 79 ,90,97, 99, 101, 103, 138-139, 141, and 144, 147-189 remain rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific, substantial and credible asserted utility or a well established utility.

This rejection is maintained for the reasons of record. Certain claims are no longer rejected, as arguments regarding dependent claims producing a result of “reference” versus “perturbed”, disease state, or course of disease can provide specific substantial and useful results to the skilled artisan. However, the claims which do not recite a specific, substantial or credible utility, or well established utility remain rejected for the reasons of record.

Claims 1,6 , 9 11, 13, 15-16, 65, 70, 73, 75, 77, 79 ,90,97, 99, 101, 103, 138-139, 141, and 144, 147-189 also rejected remain under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific, substantial and credible asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

Conclusion

Claims 1,6 , 9 11, 13, 15-16, 65, 70, 73, 75, 77, 79 ,90,97, 99, 101, 103, 138-139, 141, and 144, 147-189 are rejected.

Claims 7, 8, 71, 72, 74, 76, 78, 80, 95, 96, 98, 100, 102, 104, 145, 146 are objected to as being dependent on a rejected claim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary K Zeman whose telephone number is (571) 272 0723

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marjie Moran can be reached on (571) 272 0720. The fax phone number for the organization where this application or proceeding is assigned is 571 273 8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

Art Unit: 1631

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/Mary K Zeman/

Primary Examiner, Art Unit 1631